NOTES ON PATENTS AND PATENT PRACTICE

BY

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PATENTS AND PATENT PRACTICE

Contents.

PREFACE.

This work may properly be regarded only as a compilation of notes on patents and patent practice based on the personal experience of the author for a number of years past, and is intended to supply a need for some concise presentation of certain fundamental rules which may prove especially useful as an aid in the preparation of patent applications, and which may incidentally serve the purpose of helping to systematize and correct the practice in several respects.

It is not intended that this small treatise cover any particular part of the subject exhaustively, nor is it the intention in this work to take up the consideration of various authorities, which is something that is fully covered in excellent digests at present available, and in which such line of endeavor is much more fully and properly carried out than would be possible in a volume of this character.

PAUL SYNNESTVEDT.

Pittsburgh, Pa., 1906.

CHAPTER I.

The Nature of a Patent Right.

Some time ago the writer was accorded the privilege of presenting a paper before the Western Railway Club, in Chicago, entitled "What a Patent is Not," and at a later date submitted another treatise along somewhat similar lines before the Pittsburgh Railway Club, and as the subject matter of both papers seemed to be received with some interest by the members of those clubs, use will be made of some of the ideas contained in the same in presenting the initial chapter of this book.

The reason for the negative form of title "What a Patent is Not," lies in the fact that in considering the subject of patent rights, as well as of other things, it is difficult to get a clear comprehension as to what anything **is** without some pretty good idea also as to what it is not.

In considering the nature of a patent right, it is next to be noted that the grant of a patent is not made, as is often assumed to be the case, for the sake of the **inventor,** but from the standpoint of public policy, for the sake of **public good.**

That all patentees who hold **valid** patents have benefited the community is obvious from the fact that in order to sustain the validity of any patent it must, amongst other tests, stand the tests of novelty and utility; that is, it must be established that the invention is **new,** and adds something in the nature of improvement of a **useful** character to the arts as the state of the same existed before the creation of the invention. If a patent grant took from the public the right in any thing of a determinative or definite character, or a right in any property formerly possessed by the public, it would be inconsistent with the spirit of our age and obnoxious to people of all classes, as was, in fact, the case with some of the older statutes and special privileges which existed at different times several centuries past in England.

In the words of Bentham, in his Rationale of Rewards, published several generations ago, a patent "is an instance of a reward peculiarly adapted to the nature of the service, and adapts itself with the utmost nicety to those rules of pro-

portion to which it is most difficult for reward, artificially instituted by the legislature to conform. If confined, as it ought to be, to the precise point in which the originality of the invention consists, it is conferred with the least possible waste of expense. It causes a service to be rendered, which without it, a man would not have a motive for rendering; and that only by forbidding others from doing that which, were it not for that service, it would not have been possible for them to have done. Even with regard to such inventions, for such there will be, where others besides him who possesses the reward have scent of the invention, it is still of use by stimulating all parties and setting them to strive which shall first bring the discovery to bear. With all this it unites every property that can be wished for in a reward. It is variable, equable, commensurable, characteristic, exemplary, frugal, promotive of perseverance, subservient to compensation, popular and reasonable."

That the patent system is distinguished by having an origin of reasonable antiquity is evident from the fact that we find that in the reign of Edward III, on representation to him of the feasability of making a "philosopher's stone," that monarch "issued a commission of two friars and

two aldermen to inquire into the matter, and, on their reporting in its favor, granted to them and their assigns the **sole** privilege of making the philosopher's stone."

Nearly all of the earliest forms of such grants in England, dating several centuries back, were of similar characteristics to those of our present patent grant, but the special privileges of those early days were by degrees perverted from their primary purpose, and, under the pretense of a better government of trade, the prerogative of the Crown was employed, in return for pecuniary considerations, in sanctioning certain individuals and corporations in the practice of various oppressive monopolies. The evil of this grew until in the reign of Elizabeth, large numbers of the necessaries of life were controlled by such monopolistic patentees.

Thus, at one time, there were included in such oppressive special grants the exclusive rights of trade in salt, iron, powder, vinegar, paper, starch, tin, sulphur, and a multitude of others.

The monopolists were so exorbitant in their demands that they raised the price of salt from 16 pence a bushel to 14 or 15 shillings. Such high profits naturally began to attract intruders upon their commerce, so that in order to secure them-

selves against encroachment the patentees were armed with high and arbitrary powers by the councils, by which they were able to oppress the people at pleasure, and to exact money from such as they thought proper to accuse of interfering with their patent.

Thus the patentees of saltpetre were granted the power of entering every house, "and of committing what havoc they pleased, in stables, cellars, or wheresoever they suspected saltpetre might be gathered, and they commonly extorted money from those who desired to free themselves from this damage or trouble; and while all domestic intercourse was thus restrained, lest any scope should remain for industry, almost every species of foreign commerce was confined to exclusive companies, who bought and sold at any price they themselves thought proper to offer or exact." (Coryton on Patents, ed. of 1855, p. 28.)

"Even Elizabeth's House of Commons rang with angry complaints. On the 20th November, 1601, a great debate upon the subject took place, on an attempt by Lawrence Hyde to introduce 'A Bill for the Explanation of the Common Law in certain Cases of Letters Patent.' After much discussion as to whether the proceedings should be by bill or by petition to Her Majesty, but before

anything was concluded upon, the Queen sent a message to the House importing that the monopolies should be revoked." (ibid.)

In excusing the objectionable grants, the Queen, in a message to the Commons, said: "Since I was Queen, yet never did I put my pen to any grant but upon pretense and semblance made unto me that it was both good and beneficial to the subjects in general, though a private profit to some of my ancient servants who have deserved well, but the contrary being found by experience, I am exceedingly beholden to such subjects as would move the same at first. That my grants should be grievous to my people, and oppressions to be privileged under color of our patents, our kingly dignity shall not suffer it; yea, when I heard it I could give no rest to my thoughts till I had reformed it."

While subsequently to the events just narrated special grants in restraint of common trade were gradually reduced in number to practically nothing, exclusive privileges in reward of **invention** have remained, and there is reason to believe that the practice of making grants of the sole use of inventions originated in England, and that the English system of rewarding inventors has since been copied more or less closely by almost every European power. Our own system is based upon

it in many respects, although differing greatly in organization and detail, and the characteristics or nature of the grant remain to this day, after centuries of time, substantially the same,—the securing to an inventor, for a limited time, the right to **exclude** others from practicing his invention save on license secured from him, wherefrom he secures his pecuniary reward.

Most men who are blessed with at least ordinarily astute minds, naturally suppose that when an inventor takes out a patent he gets thereby a right to proceed unmolested with the manufacture, sale and use of his invention. That is not the case, however, as we shall see from a little investigation.

The origin of the erroneous idea above stated may, perhaps, be traced to the language employed in the patent grant itself, and in the constitutional clause which is really the basis of the patent system.

It was provided in the Constitution that Congress should have the power "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." Under this provision of the Constitution, laws were passed providing for the grant of patents. The

foundation upon which such laws are built involves the idea of a contract between the inventor and the public. In exchange for a full and complete disclosure of the invention, to be preserved in the public records, and accessible at all times to the public, the government agreed to secure to the inventor the **exclusive** right to his invention for a term of years. From the beginning, the language employed in the patent itself followed the wording of the above constitutional clause. Notice, for example, the fac simile reproducted on page 15, signed by George Washington and countersigned by Thomas Jefferson, which is taken from what is said to be the first patent ever issued by the United States. It was granted Jan. 31, 1791, to Francis Bailey, of Philadelphia, and related (to quote the patent itself) to certain "Methods, not before known or used, for forming punches, by which to impress on the Matrices of Printing Types, whether such Types be for Letters or Devices, as well as to impress on any Metal or other substance capable of receiving and retaining impressions, various Marks which are difficult to be counterfeited."

The grant recites that "the said Invention appears to be useful and important," and that "in pursuance of the Act entitled 'An Act to promote the progress of useful Arts,'" there is granted "to

The United States.

To all to whom these Presents shall come Greeting.

Whereas Frances Bailey of the City of Philadelphia in the State of Pennsylvania, Printer, hath invented certain Methods, not before known or used, for forming Punches, by which to impress on the Matrices of printing Types, whether such Types be for Letters or Devices, as well as to impress on any Metal or other Substance capable of receiving and retaining Impressions various Marks which are difficult to be counterfeited; and the said Invention appears to be useful and important. These are therefore in pursuance of the Act, entituled "An Act to promote the progress of Useful Arts", to grant to the said Frances Bailey, his Heirs, Administrators and Assigns, for the Term of fourteen Years, the sole and exclusive Right and Liberty of using, and vending to others the said Improvement, according to the true Intent and Meaning of the Act aforesaid.

In Testimony whereof I have caused these Letters to be made patent and the Seal of the United States to be hereunto affixed. Given under my Hand at the City of Philadelphia this Twenty ninth Day of January in the Year of our Lord one thousand seven hundred and Ninetyone and of the Independence of the United States of America the Fifteenth.

G. Washington

By the President

Th. Jefferson

City of Philadelphia January 29th 1791.

I do hereby certify that the foregoing Letters patent were delivered to me in pursuance of the Act, entituled "An Act to promote the progress of useful Arts", that I have examined the same, and find them conformable to the said Act

Edm Randolph
Attorney general
of the
United States

Type Patent

Delivered to the within named Frances Bailey this thirty first of January 1791

Th. Jefferson

the said Francis Bailey, his Heirs, Administrators and Assigns, for the Term of fourteen years, the sole and exclusive Right and Liberty of using and vending to others the said Improvement, according to the true Intent and Meaning of the Act aforesaid."

The essential features of the grant have not really been changed since the foundation of the patent system over one hundred years ago.

On another page will be found reproduced a fac simile copy of the grant of a patent recently issued to Mr. Edgar W. Summers, of Pittsburgh, Pa., on a Car Truck. Examination of the terms of this modern grant will show that it does not differ materially in substance from the early one, except perhaps in the recital of the several steps taken by the inventor to procure the patent. It will be noticed that this grant also purports to convey "the exclusive right to make, use and vend said invention throughout the United States and the territories thereof."

As a matter of fact, neither of the above grants give the inventor in all cases the right to make, sell, or use his own invention, but only the right **to prohibit or prevent others** from making, using or selling his invention for a definite number of years, for the infringement of which right he may,

No. 740,605

THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

Whereas Edgar W. Summers

of Pittsburg, Pennsylvania,

HAS PRESENTED TO THE **Commissioner of Patents** A PETITION PRAYING FOR THE GRANT OF LETTERS PATENT FOR AN ALLEGED NEW AND USEFUL IMPROVEMENT IN

Car-Trucks,

A DESCRIPTION OF WHICH INVENTION IS CONTAINED IN THE SPECIFICATION OF WHICH A COPY IS HEREUNTO ANNEXED AND MADE A PART HEREOF, AND HAS COMPLIED WITH THE VARIOUS REQUIREMENTS OF LAW IN SUCH CASES MADE AND PROVIDED, AND

Whereas UPON DUE EXAMINATION MADE THE SAID CLAIMANT IS ADJUDGED TO BE JUSTLY ENTITLED TO A PATENT UNDER THE LAW.

NOW THEREFORE THESE **Letters Patent** ARE TO GRANT UNTO THE SAID

Edgar W. Summers, his HEIRS OR ASSIGNS

FOR THE TERM OF SEVENTEEN YEARS FROM THE sixth DAY OF

October ONE THOUSAND NINE HUNDRED AND three

THE EXCLUSIVE RIGHT TO MAKE, USE AND VEND THE SAID INVENTION THROUGHOUT THE UNITED STATES AND THE TERRITORIES THEREOF.

In testimony whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed at the City of Washington this sixth day of October in the year of our Lord one thousand nine hundred and three and of the Independence of the United States of America the one hundred and twenty-eighth.

E. L. Allen

Commissioner of Patents.

under the law, recover damages or profits from the infringer.

That by the grant of a patent the government does **not** give the inventor the right to make, sell or use his invention, is evident from the fact that, prior to such grant, **he already has such right,** provided there are no patents to earlier inventors which he infringes; and in case such other patents or conflicting rights exist, the mere issue of a patent to him will not relieve from the charge of infringement any attempt to make, use or sell his patented device, whether such attempt be made by him or anyone else.

It is the word "exclusive" that really gives character to the grant—the right to **exclude** or **prohibit** others from doing something. Whether a patentee has the right to operate under his own patent or not, is entirely dependent upon the existence or non-existence of prior claims held by others, which would be infringed by such operation; and this is a question entirely different from the question as to whether this particular patentee's rights are valid, or infringed by later inventors.

What has been said concerning the nature of a patent grant will, perhaps, help to explain what so many have difficulty in understanding, i. e., how it can be possible for more than one to hold

what appears to be a valid patent upon substantially the same thing. As a matter of fact, that is **not** possible; it is only an appearance. The difficulty generally arises in a case where one man holds what is known in patent law as a **broad** or **generic** patent upon a certain invention which has been improved upon by others in various ways, the others securing patents upon their several **improvements.** The man who holds a broad or generic patent has a right to prohibit its use by everyone else, so long as his grant continues alive; but he has **not** the right to prevent or prohibit others from exercising their inventive faculty in the development of **improvements** upon his invention, nor has he the right to prevent or interfere with others securing patents upon such improvements. That would not "promote" the progress of science and the useful arts, but manifestly "retard" it. As has been well stated by the U. S. Supreme Court, the disclosure of a broad, generic or pioneer invention not only does not stop or check development along the same line, but rather serves to stimulate it.

To illustrate the distinction between what is known as a generic and what is known as a specific patent, and the rights of the parties holding the same, let us take, as an example, the case of a car coupler. Suppose A invents an improved vertical

plane coupler or draw-bar, comprising, essentially, three parts, a **head,** a **knuckle** and a **locking pin.** Suppose he is the first who has ever employed such three parts in combination in a coupler. He is entitled to and can procure a patent upon the combination between a head, a knuckle and a locking pin, his claim being entitled to the broadest interpretation by the courts.

Suppose B now takes a coupler made in accordance with A's invention, and, in using the same or studying upon it, works out a different form or arrangement of the locking pin or knuckle. B is entitled to procure, on the filing of proper papers, a patent on his invention, claiming his specific or particular improvement on A's generic invention. The existence of A's patent has not had, and obviously should not have, any effect at all in preventing B from securing a perfectly valid patent on the specific improvement which he has invented; for a patent, be it remembered, does not necessarily insure the patentee the right to **make** or **use** the invention, but primarily the right to prevent others from doing so. The government has given B a patent on his specific improvement, although it is to be remembered that there has been a prior generic patent issued to A, broadly covering all couplers employing the combination of a head,

knuckle, and a locking pin. B's patent, therefore, in this case, does not give him the right to make or use his own invention, because his invention cannot be made or used except in making or using the invention which is already patented by A. Obviously, if this were not so, the value of A's broad patent would be destroyed as soon as anyone patented an improvement upon it. The enforcement of such a rule would practically upset the whole patent system, since nearly every invention is or may be broad or generic to others, in the same line, which follow after.

What the government does give to B is simply the right to **prohibit anyone else** from using that which he originated, or his particular contribution to the art, which in this case was a specific improvement upon the locking pin or knuckle of A's coupler. A, until his patent expires, can, if he chooses, entirely prevent B from putting his invention in practice, for the reason that B's invention is of such a nature that it cannot be used except in conjunction with the invention made by A. In the words of the patent practitioner, it is but one specific form of a generic structure, of which A holds the monopoly.

On the other hand, while A is entitled to prevent B, as well as everyone else, from making or

selling any couplers embodying the broad or generic invention on which A holds a patent, B, by virtue of his patent and rights thereunder, can entirely prevent A from appropriating or making any use of his specific or improved form of knuckle or locking pin. If A wants to incorporate B's improvement in his coupler, he must get the consent of B by license or purchase. In the absence of such consent, he is confined to the use of his generic form of coupler, without B's improvement.

The above illustration may serve to make plainer the peculiar nature of a patent grant, already explained, i. e., that it is not a grant by the government of the right to make, use or sell a man's invention, but merely a grant of the right to prevent or prohibit others from making, using or selling it unless they pay tribute to the patentee. It is largely because of this distinction that it is possible for so many perplexing cases to arise in which it appears to the uninitiated as if a man, having procured a patent, has in some way been unjustly treated, because he finds, when he attempts to exploit his invention in practical work, some other patent previously granted stands in his way. It is incumbent upon patentees, as well as those contemplating purchases, manufacture, or other dealing involving patent rights, to find out

just what relation the patent in controversy bears to others in the art, and guide their actions accordingly. The mere issue by the government of a patent to an inventor shows nothing more than the **prima facie** ownership, vested in the grantee, of a right to prevent others from making, using, or selling, the particular invention or specific improvement defined in the claims, and indicates nothing at all as to the existence or non-existence of any prior right in others which may be infringed by commercial working under the patent. That can only be ascertained by personal investigation or search by an attorney. It is said the patent shows only **prima facie** ownership, because all patents are subject to be defeated in case proper defense can be brought against them in the courts.

CHAPTER II.

Patent Office Practice Compared with Court Practice.

In patent law there are, in general, two different kinds of work, the first treating of all those steps necessary to the procuring of a patent, and the second treating of the vicissitudes encountered by the patent after it is issued.

It is the purpose of this work especially to consider the first of the above branches of patent law. A complete study of this branch should include not only a careful analysis and study of the United States Statutes bearing on the issue of patents and of the Rules of Practice of the United States Patent Office published from time to time, but it should also include a study and consideration of, first, the facilities which the government has provided for putting into effect the statutes

passed by Congress with relation to the subject of patents, and, second, the peculiarities, or, if they may be so called, eccentricities, that have become inseparably associated with this kind of legal work, under the last mentioned division being included a detailed consideration of the character and reason for the actions taken by the Examining Corps and other officials in the Patent Office, and of the nature and legal effect of amendments inserted by the applicant. There has been a disposition manifested on the part of some practitioners, well skilled in patent law, to regard this branch of the patent law with something of contempt, or at least aversion, and this, it is submitted, is not justified by the character of the work which requires skill of the highest order, legal and literary, as well as mechanical.

To get a good patent on an invention is a work of great importance, and in some cases also of great difficulty. The United States Supreme Court has apparently held in effect that "invention" cannot be defined, but has to be determined by negative tests, that is, by a kind of process of exclusion, and yet, in spite of this, the attorney who prepares and prosecutes the application for a patent shoulders the burden of disclosing the invention so that it may be used by others skilled in the art,

while at the same time covering or protecting the rights of the inventor by well defined claims.

It is the writer's observation that the patents which have been allowed by the Patent Office and passed to issue only after the most protracted contest between the attorney and the Patent Office are in many cases very much better for having gone through what we may not inappropriately call this clarifying or rectifying process. This emphasizes the importance of a thorough, or better, an exhaustive, study of the invention and the salient features thereof prior to the preparation of the application, and also emphasizes the importance and value of this work.

In the work of patent soliciting there is something (not present in work connected with patent litigation), which is somewhat akin to the creative work required of the inventive genius himself. The inventor, it is true, makes the invention, as a machine, if it be a machine, or an art, if it be an art, but it is the attorney who prepares and prosecutes the application, who must put that invention into words, who must separate all those things which are novel from the prior art, and who must, making due allowance for everything that is old, so define and describe all those things which are new as to clearly differentiate between them and lay bare be-

fore others skilled in the same art all of the elements that characterize the invention and the mode of carrying it out, and at the same time, in proper language, hedge about the rights of the inventor in such a manner that trespassers can be kept off.

CHAPTER III.

Relations Between an Inventor and his Attorney.

The first interview between an inventor and his attorney is something of considerable interest. Many inventors inquire at the outset as to the advisability of taking out a caveat on their invention. It is astonishing how persistent the idea is that the first thing to do with an invention is to file a caveat on the same, although no one having this idea seems to know why, or to understand clearly just what a caveat is.

The attorney then rehearses the story which he has told on many prior occasions, explaining why a caveat under our present law is not a good investment, and that it is better to prepare and file a complete application, first making a search, if that seems desirable, in order to determine the exact status of the invention with reference to the prior

art. In most cases it is advisable to make a preliminary examination before preparing an application for patent. It is not, in many cases, so much because there is a liability or a probability that some anticipating patent will be found, as in order to find how near to the invention the devices disclosed in the prior art may be. A knowledge of the art is very useful, and in most cases necessary, to enable the attorney to prepare the proper kind of an application.

The proper course of procedure having been thus explained, a suggestion as to terms now follows. Here is where both attorney and client commonly make one of the greatest mistakes made in the practice. It is usual for a patent solicitor to charge a fixed fee for the combined work of preparing the papers for an application, and for prosecuting the same until notice of final allowance, provided no appeals or other special proceedings of like kind arise. This is unfair, both to the attorney and the client. It is possible to make some kind of an estimate, when the inventor discloses the device, as to how much labor will be required to prepare the original papers for an application on the same, but it is obviously a physical impossibility to determine in advance, how much work or worry will be necessary to secure the allowance of the ap-

plication after it has been once filed in the Patent Office. The latter portion of the labor, termed the work of **prosecution,** is in many respects, the most important part in the entire process of securing the patent. To fix a price in advance for doing this work, is exactly as though one were to say to another, "I understand you have some labor for me to perform, and I know that it is in the line of my business, but I have no conception whatever as to how much time it will take to do it properly, or as to what the difficulties encountered in connection with it may be. I will undertake to do the work for you, however, for a certain fixed sum, say twenty-five dollars ($25.00), and will ask you to pay the same in advance." The absurdity of such a proposition is apparent on its face, and yet that is practically what is done right along by most attorneys who charge a fixed fee for prosecuting an application for patent. The writer's experience shows that some applications are pending in the office for years, and have to be amended and rewritten, and argued, time out of mind, before they are put in satisfactory shape for issue, and before the office objections are all overcome, while other applications are either passed to the issue division on the first action, or require but a few formal corrections before final allowance. In the work of prosecution of

a pending case in the office, the personal characteristics of the examiner immediately in charge of the case, as well as the examiner in charge of the division to which the case relates, and in case of appeal or interference of the tribunals having charge of the proceedings, all enter somewhat into the course of procedure. The nature of the invention, the nature of the references discovered as bearing on the same, the nature of the disclosures contained in the application papers, and the various questions of law and practice which arise in connection with the application, all tend to increase the uncertainty relative to what will be involved on proper prosecution of the case.

I say "proper" prosecution of the case, because it is of course evident that there is an improper method of prosecuting the case, in which short-cuts may be taken, whereby many of the difficulties and delays ordinarily encountered, may be avoided. The result of the plan ordinarily followed, of charging a fixed fee for the prosecution of a case, is either that the attorney does a great deal of work for which he is not paid at all, or that the case is slighted, and the patent issues with some defect, which works injustice to the client. The profession should strive by every means in its power to abolish this unfair and ill considered practice. The writer's

experience has been that it is more satisfactory to the client, as well as to the attorney, to take work on a basis which insures the attorney compensation for the work which he does, and insures the client good service at all times. By making the initial charge for the preparation of the papers for filing a little lower than the usual amount and carefully keeping track of the time afterwards devoted to the work of amendments and arguments, the result desired can be easily secured, and the effect on the quality of the work is really surprising.

The matter of fees between the inventor and attorney having been satisfactorily settled, and the attorney having thoroughly mastered the principles and details of the improvement, he transmits the same to his correspondent in Washington, together with sketches or other data, and receives in a few days or a week at most, a reply detailing the report of the correspondent's search, accompanied by copies of all such references as have any bearing upon the proposed application.

If it be now determined from an examination of the patents returned from Washington with the report, that the improvement is a patentable one, and that it is possible to secure claims of sufficient value to warrant the filing of an application, the client is advised to that effect, and transmits in-

structions to proceed with the preparation of the application.

CHAPTER IV.

Preparation of the Papers for an Application for a Patent.

The first thing required in the preparation of papers for an application is usually the making of a drawing, and as to this the main point to be kept in mind is the fact that it is much better, so far as securing good patent protection is concerned, to have the illustration as simple as possible, and to have it clearly show the features which are to be covered in the claims, and not anything else which can well be omitted or which is immaterial to the invention on which protection is sought. It is in many instances a fact that a single clear perspective view illustrating the inventive idea is of more value than several sheets of finely executed mechanical structures, which, although they may be accurate as to details, may not clearly set before the eye the

inventive thought which the patentee seeks to protect.

Proper drawings having been prepared, the next thing necessary in doing this work is for the attorney to make himself thoroughly familiar with the invention, and to make a careful analysis of the same, separating out from the mass of data generally supplied by the inventor, so much as is thought to be absolutely essential, as contradistinguished from that part which is descriptive merely and relates more to the particular embodiment of the inventive idea shown in the device submitted, which is not essential to the invention itself.

Of course different attorneys have different methods of proceeding, in order to accomplish this result, and it is quite likely that there are features of merit about a number of the methods employed, but the writer hereof has found in his experience that the best plan to pursue, is to make a diagrammatic representation of what he thinks to be the broadest allowable claim, putting the several elements intended to be incorporated in such claim in tabulated form one above the other, and placing opposite each of the same divers limitations which can be introduced in claims of more limited scope, which it is thought advisable to file, in addition to the broader claim or claims.

Here it may be well to say a word as to multiplicity of claims. It is not considered good practice to file cases with a very large number of claims, particularly if the claims be constructed on what is known as the permutation principle, or as the writer has heard it called "the House that Jack Built" plan, that is, by the employment of a basic combination, to which in each of the several claims in succession, there is added some single modification or change just sufficient to differentiate each claim from the one which precedes it, but not really sufficient to introduce any more novelty into the combination. Careful examination of the reported cases will show that the patents which have received the best treatment from the Courts are those which have but few claims, and those expressed in simple straightforward language. In most of the important litigation with which the writer is familiar, the fight in Court has generally been centered around some single important fundamental claim, all of the rest being entirely subordinated to this. It has long been a pet theory of the writer, that great improvement in the practice in many respects would result were a rule to be adopted, limiting each patent to a single claim. This idea, it is true, has been scoffed at by many prominent attorneys in the profession, to whom it has been

submitted, but it is still thought to contain considerable of merit. If the reader will examine those cases which come immediately under his notice, he will find a great many in which the essential feature of the invention can be expressed, and in reality, well protected by a single claim. It is known that in order to stand the test in Court, every claim must be capable of standing alone, that is, it must present a patentable combination, such as will support a claim of validity, and in fact must be treated just as though it were the only claim in the patent. Of course the adoption of such a rule as the one just proposed would largely increase the number of issued patents, since it is common practice to cover, in a number of different claims in one application, a number of different features, as they are called, of invention. It is thought by the writer that the amount of material to be looked over in making a search, however, would not be materially greater under such a rule, than it is under the present practice, and such material as would have to be examined would certainly be in much better shape for making accurate examination.

Thus, were the single claim adopted, it would, in the first place, very materially reduce the number of patents in which more than a single sheet of drawing is requisite. Each claim would be more

carefully constructed by the solicitor, and it is sincerely believed would receive more careful and liberal treatment by the Courts, since they would be loath to defeat a patent on such slight technicalities, as now sometimes suffice, to enable an infringer to evade the consequences of his infringing act. It is known in the profession that the practice of the Courts in some of the foreign countries, is much more liberal than it is in the United States. They do not place the same restriction about the protection afforded by the patent, and in interpreting the meaning of the claim, they pay more attention to the disclosure of the patent as a whole, taking into consideration both the specification and the drawings, and affording a more liberal application of the doctrine of equivalents. This, it is thought, is as it should be, and this, it is sincerely believed, would soon become more common practice in our own Courts, were the patents themselves simplified in the manner suggested. Those who have had much experience in making validity and infringement searches, will testify as to the great amount of labor involved, and as to the difficulty resultant upon the granting of a large number of claims in single patents. The practice in use makes it necessary, in order to secure reliable results in any such search, to review every claim of every

live patent in all analogous classes, at least, antedating the invention under examination. Where some of the patents to be examined have from 75 to 100 or more claims, it is evident that this becomes a very troublesome and tedious task. Those who have had experience in connection with this work, will also recognize the fact that in patents containing such a large number of claims, there are nearly always certain claims which can be classed together in groups, characterized by certain fundamental combinations, which, as a general rule ought to have been represented in the issued patents by but a single claim, and which, if tested on a hard fight in Court, would be found to contain, as to each of the said groups, only a single patentable combination. If some of the claims of a group contain elements essential to that combination, which are not contained in the other claims of that group, the claims not containing such elements cannot be sustained unless such elements, by implication, be read into them, for otherwise they do not express a patentable combination under the law. On the other hand, if certain of the claims contain the fundamental combination with elements added which are not essential, they really add nothing to the protection afforded by the fundamental claim, since the minor details added do not import validity

into the combination fundamentally considered, and a single claim to such fundamental combination, would sufficiently and thoroughly dominate the art.

Perhaps the points in favor of the single claim theory, can be best summarized in a statement to the effect that since every single claim of every patent must define a patentable combination, or in other words, a patentable invention capable of standing all the tests to which it is submitted by the Court, including the tests as to novelty, utility, and invention, there appears to be no good reason why each claim should not be considered as an invention separate and distinct by itself, for it is in fact such, and there appears to be no good reason why more than one invention should be patented in a single patent. It has been urged by some with whom this matter has been discussed by the writer, that this practice would require a large duplication of drawings and descriptive matter, but this, it is thought, is not the case. There would undoubtedly be required in some instances a duplication of the descriptive matter and illustrations, but it would not be necessary to go to anything like the expense which is sometimes claimed. Take for example a patent on an engine compressor; patents of this kind have been issued with claims on the steam mechanism, claims on the compressor valves, and

still other claims on the other features of construction, such as the framing or cylinder devices. The correct illustration of any one of these several features does not properly require an illustration of the entire compressing apparatus. The compressor valves may be correctly illustrated by themselves, and to any one skilled in the art such illustration is perfectly intelligible without any representation of the other parts of the machine. The steam controlling valves are capable of representation by themselves, so as to be clearly intelligible without other parts having to be shown at all, and the like is true of any of the other portions of the mechanism. The same thing will be seen on a moment's reflection to be true of any other class of device, a printing press, an elevator, a steamboat, an improved transmitting gear for an automobile, or a machine for threading bolts, or almost any other machine which one may call to mind.

The reason why it is assumed by some that duplication of description and illustration will be required to a large extent under such a practice, is, because of a practice very prevalent of making claims to a combination larger or more extensive than the invention which is really the subject matter of the novelty of the patent. For example,

in claiming a certain improvement in an igniting device for use in a gasoline or oil engine, the claims would, by some, be framed to the entire engine, as "An engine comprising the combination of a cylinder, a piston, and other parts of the mechanism, with igniting points constructed in a certain specific manner," whereas this claim would be better for all the purposes of the patent, were it drawn as a claim to an igniter characterized by certain specific features of construction, without any mention of the engine, or without bringing the engine or any of the other parts of the engine into the combination. The same thing will be found to be true in reference to patents issued on certain features of car construction. Take, for example, the standard M. C. B. car coupler. Where the invention, properly considered, relates only to a specific improvement in some little detail of the locking mechanism that holds the knuckle in place, it is common practice with some attorneys to make the claims so as to include in the combination, the coupler-shank, the head, and the knuckle itself. The result of this practice is disastrous to the protection sought to be secured to the inventor, because the application of the invention itself, in exactly the same form, applied to other mechanisms, not including all of the other

elements included in the combination claim of the patent, leaves the inventor patentee without recourse.

Of course if any plan were to be adopted requiring the filing of a separate case for every claim sought to be secured, the cost of procuring each individual patent, ought to be materially reduced, both in the item of government charges, and in the item of attorneys' fees. The work of preparing and prosecuting an application of this kind, would be materially less than that required in an application involving a number of different inventions, and the number of cases filed, being necessarily greater, the revenue to the government would be materially increased, and thus permit, without sacrifice, a material reduction in the cost of each case.

To return now to the subject of this chapter, that is, the preparation of papers for an application, and taking up the same where it was left, it is evident that the preparation of a diagramatic representation of the combination sought to be covered in the claims will be of great assistance to the attorney in dictating the specification and the claims themselves. It is neither necessary nor desirable to illustrate anything on the drawings not essential to a clear understanding of the invention defined in the combinations claimed. On this account, it is

well, in most cases, to prepare a diagramatic representation of the claims sought to be secured, before the drawings are made, and to use such diagramatic outline, in determining the arrangement and extent of the several figures to be shown. The solicitor, as well as the Patent Office, will find the work greatly facilitated, if the drawing is so made that practically the entire invention covered in the application, is disclosed on some one single sheet, other figures being added only to make clear certain points of detail. This practice is more readily followed where the application is limited to a single or at all events to a small number of claims.

The drawing having been prepared, the solicitor, with the drawing and diagramatic representation of the claims before him, can now begin the dictation of the specification. The Rules of the Patent Office define with considerable precision what shall be put into such specification, but there are some things not covered in the Rules, which are of great importance, and which each solicitor heretofore has had to learn for himself, in many cases from bitter experience.

In the first place the statement of the object of the invention, preceding the detailed description of the several figures, ought to be clear and complete. A specification prepared with a full discus-

sion of this kind in the opening part, is much more intelligible to a Court, than one which begins immediately by a statement that on figure 1, I have shown so and so and on figure 2 I have shown so and so, and figure 3 is a detailed section taken on the line 3—3 of figure 2, etc.

It is a practice of some attorneys, and some of very high standing in the profession, to introduce in the opening part of a specification some statement equivalent to a statement that the invention "consists in" certain features. Sometimes it is stated as follows:

"My invention comprises certain essential elements, which may be described as follows."

The writer is opposed to this practice for the reason that the Statute requires a limitation and definition of the invention, i. e., what are the essential elements thereof, or in other words what the invention "consists in" in the **claim** which comes at the end of the specification, and an introduction of such a statement in the opening part of the specification is substantially the same as a re-statement of the claim, and is liable to do damage to the protection accorded by the patent by introducing some limitation, not really essential to the invention, and not actually included in the claim as finally stated, but which by interpretation of the Courts, in view

of the opening statement, may be afterwards read into the claims, and deprive the patentee of his proper protection.

While it is thought by some not to be desirable to introduce any statement regarding the prior art in the introductory portion of a specification, the writer has found in his experience, that in many cases it is difficult to make the invention clear without some reference to the bearing it has upon the prior art structures. Matter of this kind, however, when introduced, should be stated as generally as possible, and without derogatory remarks concerning such prior art structures, save in so far as such may be inferred perhaps from the statement of advantages secured by the improvement forming the subject-matter of the application in course of preparation. The theory should be, not that prior patented devices, are in any manner defective, but rather that the subject-matter of the present application, is an **improvement,** and marks an advance whereby the art is carried a step further, and humanity is one degree better off than it was before.

A general outline, particularly specifying the object or beneficial results accomplished by the improvement, having been given, the next thing to be inserted is, as required by the Rules, a statement in

detail as to what is shown in the several figures illustrated in the drawings. As a general rule, the writer has found, that this portion of the specification is of comparatively little value, in determining the subject-matter of the patent. It is at the same time something apparently necessary as introductory to the detailed description of the mechanism which follows, and being required by the Rules, must be put in, and should be phrased in the most concise and clear manner possible.

Following the detailed statement concerning the several figures comes now a description particularly relating to the various mechanisms employed, and the relation between the same. This portion of the specification is not intended to include, strictly speaking, a description of the **operation** of the machine, but what may more properly be defined as the **structure.** At the same time it will be found as a general rule, that this portion of the specification can be made much plainer, and easier to read and interpret by the Court, if a statement as to the object of the several parts is prefaced to the statement as to the parts themselves, and the reference numerals which have been applied to them. The mechanism if it be complicated, and involves the use of a large number of different pieces, can also be made clearer, if a brief descrip-

tion is given dividing the several parts of the machine into different groups of elements, with the object and purposes of each of the several groups clearly stated.

The point referred to as involving a difference between a statement of structure, afterwards followed by a statement of the object to which such structure is incorporated in the machine, and a statement of the object prefaced to a statement as to the structure, and the reference numeral applied thereto, would be best evident perhaps from an illustration, as follows. Suppose the descriptive matter to relate to a press feeding machine. If the statement of the specification begins, "the part numbered 1 shows a cam, the part 2 is a lever actuated by said cam, and the part 3 a rocking-shaft actuated by said lever, all of said parts co-operating in producing a movement of the part 4, which effects a feeding of the paper to the press," it is obvious that the device does not as readily come within the grasp of the mind, as it would if the statement were made as follows: "For the purpose of feeding the paper to the press, mechanism numbered 4 is provided, which receives a reciprocating movement through the instrumentality of a rocker-shaft 3, which is rocked by a lever 2, receiving its motion from a cam 1, which is revolved

by the driving gear." It is believed that a careful study of the illustration above given will show that it is almost always desirable to make a statement of the functional object of a part, before identifying the same on the drawings by the reference numeral. This turns the mind in the direction of the use of the thing, and prepares it to receive a better impression as to the structure. It has been well said that "necessity is the mother of invention," and there is no doubt that the reason for the difference above pointed out, is to be found in this statement. The **necessity,** or **use,** or **function precedes,** and the **structure** or invention **follows,** in order to meet the requirements of the case. Every attorney who has had much occasion to examine specifications prepared by others, has had experience showing the force of these statements. He has, undoubtedly, many times, with a feeling of relief, turned from a specification prepared along the first mentioned lines, to one, in which a clear statement of the functional use of a part is introduced preliminary to the description of the structure of such part, and the reference numerals whereby it is identified on the drawings.

Having completed the description of the structure of the device, the next thing in order is a disclosure of the operation, taking it by steps in regular

series. This should also be coupled with references to the advantages secured by the improved and novel operation, and by a statement or statements as to equivalency of other parts which it may be thought could be substituted in place of the specific structures shown, although the last mentioned matter should be inserted with great caution, since these questions of equivalency are really for the Court, and the position the invention occupies with reference to the prior art, should really be the factor which determines this point. Additional reason for caution in stating anything as to what would be or would not be equivalent, is found in the fact that a mis-statement on this point, may enable an infringer to show anticipation in a certain prior device, which is not in reality equivalent to the device covered by the patent.

Having completed the descriptive matter in the specification the next thing in order is, of course, the claim or claims. Here particular use should be made of the diagramatic representation prepared in the first instance, and the claims dictated therefrom, **carefully avoiding the inclusion in any one of them of any element not essential to the combination sought to be expressed.** Probably more claims are defeated in Court, or fail to sustain the rights of the inventor to what he has really invented, be-

cause of the inadvertent inclusion of some element or elements not absolutely essential to the operative combination of the real invention, than from any other cause. Great care ought to be exercised in every case to secure at least one broad fundamental claim covering the most important feature, as it is called, of the improvement, without incorporating into such claim anything whatever which may act as a limitation or restriction of the patentee's rights to less than he is entitled to monopolize.

A patent issued on such a claim, is a good and valuable patent, even though there are no other claims in it at all; and provided the subject-matter which might be covered by other claims, be patented independently, it is thought that such a patent is all the better for containing but one claim, since it will be more liable to receive friendly consideration by the Court, and will give less opportunity for the introduction at the hearing, and in the record, of extraneous, or confusing matter, which tends to cloud the real issue of the case.

Where, as in the present practice, a number of so called different "features" are to be covered in the same case, great care should be exercised in formulating the claims to each of the several features, so that each of the claims shall stand like the proverbial tub upon its own bottom, and not be

mixed with any limitations, properly belonging to any of the other features. This is another place where many attorneys fail to secure proper protection for their clients. In other words, each claim, to each feature, should be considered as though it were the only claim in the patent, and it should be worded in such a way, as to cover just those elements which are absolutely essential to an operative device embodying such particular feature, and not anything which could be dispensed with, or for which other things not equivalent might possibly be substituted.

What has already above been referred to as the "permutation" system of drawing claims, should be carefully avoided, save in so far as it may possibly be of use in formulating two or three different statements of what is practically the same invention. The last mentioned practice under present procedure would be in some cases admissable. The "House that Jack Built" method of preparing claims, is something which, in the experience of every practitioner in the profession, can be seen to have been productive of disastrous results. A claim having been drawn to a certain combination, including, for example, a rotating carrier for some purpose, other claims are constructed on that combination, by a copying thereof

with elements added thereto. Now, it very likely happens that in the particular machine referred to the "rotating carrier" of the combination of the first claim, may be necessary to that particular combination, or feature, but may not be necessary at all to the combination or feature covered or sought to be covered in the other claims, and yet if the permutation system be followed, this limitation will be found in every one of the claims, and enable infringers to evade all of the other claims except the first one, by the omission of the rotating carrier, or the substitution of something in place of it which is not the equivalent thereof. Thus, all of the protection afforded by the patent may be entirely nullified, by carelessness in this respect. Every attorney who makes a practice of looking over patents to render opinions thereon, has found numerous instances no doubt, where a large number of claims in a patent have all been disposed of by simply running down the column and finding the same limiting elements in all of them, as were introduced into the first claim. Whether other features of the combination are new or embodied in defendant's device or not, if all of the claims have a single limitation, which is not used by defendant, defendant does not under our law and practice infringe.

Another point which should be carefully kept in mind in the preparation of claims, is to avoid limitations such as occur when certain parts which co-operate in the performance of some operation, are specified by their **particular** or **specific names,** rather than by the employment of some broad generic term such as means, mechanism, or devices. Thus, for example, where a claim relates to a certain valve controlled mechanism, in combination with which a certain apparatus is used for producing a reciprocating motion, it would be fatal to the value of such claim as protection on the generic invention, to specify the particular form of device employed or shown, for producing such reciprocating motion, as for example, to say, "a spring" for producing reciprocating motion, where the requirement of an operative combination would be entirely met by stating it as, "means for producing a reciprocating motion," which might be a spring, and might be a motor acting positively by means of a connecting rod, or might be some other device known to the mechanic arts.

CHAPTER V.

First Steps on the Part of the Patent Office with Reference to the Application.

The application on receipt by the Patent Office is assigned to the division to which it most properly relates, and is placed in the files of such division, awaiting action by the examiner in its turn, for it is a rule of the Office that cases must be taken up in their turn, and unless some special reason is shown, it is not customary for the examiner to act on any matter out of its turn.

When the examiner reaches the case, which may be in a few weeks or may take months, he reviews the specification, and then makes an examination of the prior art which is classified in his files, and determines as to the patentability, or non-patentability of the several claims submitted, writing the attorney, or the applicant if there be no

attorney of record, as to his action upon the case, rejecting those claims which he deems anticipated, or objectionable for some other reason, and allowing such as he thinks present novel and patentable subject-matter. If, in the judgment of the examiner, division should be made, and other cases filed on certain portions, not properly related to the main case, or not properly joined together with the other subject-matter of the application, the first Office action makes a requirement for division, and this must be complied with, before action on the merits can be obtained.

As a general rule it is now that the hardest work the attorney has to do in connection with the application, begins. The examiner on reading the papers, is liable to take a very different view of the invention from that taken by the attorney in preparing the papers. He is also liable to find references, not before called to the attention of the attorney, but having a material bearing upon the scope or validity of the claims submitted. There are comparatively very few cases which go through the Office without more or less controversy between the examiner and the attorney, and it may be fairly said that as a general rule, a case is the better off, which has been fairly thrashed over in the Office, provided only, that the attorney has

studied and thoroughly mastered the subject-matter of the invention, and has persistently held out, in favor of proper claims thereon, until he has convinced the examiner, or if the examiner be obdurate, some appellate tribunal of the Office, of the justice of his case.

While it is but natural that among such a large number of government employees, as are engaged in work in the examining corps of the Patent Office, there should be some who are obtuse, some who seem to be vindictive, and some who may even be subject to suspicion or open to criticism on other grounds, still in the writer's experience, it is to be said, in all fairness, that there are a very large number, of very patient, intelligent, and well educated men engaged in this work, probably rating higher in competency and expert knowledge than any other comparable body known, and taking the average of the divisions all the way through, the work of the attorney, if it be conducted upon a basis of friendly and fair dealing, will be met more than half way by the Office, and the relations between the Office and the attorney will be both pleasant and profitable. The writer is indebted to the examiners in the Patent Office, for assistance in many cases prosecuted by him, in the way of suggestions, and citations of important references, without a

knowledge of which the patent could not have been put in proper condition.

While it must be admitted that in some divisions of the Office, the unjust principle is apparently followed, which regards the applicant for patent as a public enemy and the examiner as a defender of the public rights, still it is thought that this criticism is not to be fairly made against a large number of the divisions, and it is suggested that indiscriminate condemnation, sometimes indulged by attorneys, is not productive of beneficial results. In some respects, it is really subject for wonder that in a place, controlled, so far as the chief positions are concerned, so much by political influence, there should yet be so much of fairness, intelligence and courteous treatment.

In this connection it is submitted that the proper attitude of the Office with reference to all pending cases, should, in all fairness, be one of affirmation, and friendliness, and not of antagonism, and opposition. The patent system was devised, and is maintained, not because it is a benefit to the inventor, but because it is assumed to "promote the progress of science and the useful arts," as it is stated in the Federal Constitution. Such being the case, it is to the benefit of the public, that a just patent should be issued. It is but a logical con-

clusion, that every time a just claim is rejected, or a meritorious invention so thinned down in the application as to deprive the inventor of the proper protection, the public is thereby injured, as well as the inventor. On the other hand, if an invalid patent be issued, the harm done is not only an injury to the public generally, but also an injury to the patentee. The grant of Letters Patent, is supposed to give a man certain prima facie rights, capable of being sustained, if valid, in subsequent proceedings in Court, but if such supposed rights do not possess such capability, then the patentee, has received the grant to his detriment and will derive therefrom trouble and expense and ultimately disappointment.

It is the Federal Courts, under the statutes, which are in reality the guardians of the rights, both of the public, and of the patentee, and in view of the fact that ample provision is contained in the statutes for the protection of such several rights by the Courts, the attitude of the Patent Office certainly should be one friendly to the issue of Letters Patent, especially where there is any case of doubt. If a meritorious invention be refused protection, the public, as stated, has been damaged thereby, and the damage is in a way irreparable, whereas if a patent be issued which is not valid,

the public may be protected through examination of the art, and by the Courts.

Another word as to the examiner, from one who confessedly looks at these things through the eyes of the attorney and his client, the inventor, may not be here amiss. It seems to be the practice of a few of the employees of the examining corps, on taking up an application for first investigation, to read the first of the claims, to find a reference for the same, if one is thought to exist, and to reject all of the claims on that reference, ignoring the differences between the several claims, and the fact pointed out in the earlier part of this work, that each claim must be practically a complete operative and patentable combination in and of itself, regardless of any of the other claims, and in case of litigation in Court, would have to stand or fall alone, as though there were no other claims in the case. Of course the volume of work and the pressure to bring it up to date are to be pleaded in extenuation of this practice, but so long as the present practice of issuing a large number of claims in a single case is continued, it should be carefully observed by the examiners what the differences are between the several claims submitted, and action upon them should be based upon the merits of each by itself, and not upon a single combination, with the as-

sumption that the others are in essence just like it. It is true that under the system of drawing claims employed by many attorneys, a certain fundamental combination will be put into a large number of claims, and it is also true that if the fundamental combination be anticipated in the art, it is open to serious question whether the addition of well known elements to such combination, import patentability into the other claims based on that combination; and in such cases a rejection of all containing such combination may well be warranted, but the experience of the writer is that it is common practice with some examiners to reject a whole set of claims, differing radically from each other, on a reference which meets fairly only one of them and that, generally, the broadest one.

Another objectionable practice followed by some examiners is that of **rejecting** claims upon patents which do not properly or fairly anticipate such claims, simply for the reason as it is given, "of getting such patents into the record." It is evident that there are reasons in favor of making the record of an application show clearly the state of the prior art, and the writer of this book has no objection to that, and believes that the public good would be largely promoted if this were done to a greater extent, but it is believed it should be

done in a different way. That is to say, the rejection of claims anticipated, should be made in the first instance, and then whatever other references are found, which are thought to have important bearing upon the subject-matter which it is attempted to cover in the application, can be cited in a supplemental paragraph or statement, such as is sometimes put in by some of the examiners, in language something like this: "In amending this application, it is thought that attention should be directed to the patents to Smith No..... and the patent to Green No....." If the applicant has a really meritorious case, and if his claims in the face of the art, are valid, such action will not injure his patent, but tend rather to strengthen the same. On the other hand, if the prior art patents referred to in such supplemental clause, while not strictly or correctly anticipations of the subject-matter of the claims as stated, have such a bearing upon the subject-matter of the invention as would tend to impose restrictions or limitations upon the patent after issue, or would be of service to the public, or the judiciary, in interpreting, or defining the limit of the patent, it is right that the public should have the benefit of the examiner's work to this extent. The writer in his experience has encountered a number of cases, where he has had good cause to

be very grateful for a citation of this kind to the prior art, and has been enabled by reference to the patent mentioned by the examiner, to materially strengthen his patent. He has also had occasion to take advantage of such references, by the examiner, to get a better insight into the questions of infringement, which must be considered by all who purpose the commercial working of their inventions; and in some instances to get control of Letters Patent essential to insure him a clear field.

CHAPTER VI.

Interview Between Attorney and Client on Receipt of Office Action, and Preparation of Amendment and Argument.

The writer has always made it a practice, and his experience confirms his theory that the practice is a good one, to consult with the inventor or applicant before preparing an amendment or reply to the office action. This appears to be neglected by many attorneys, probably with the idea that the work of amendment and argument is strictly the attorney's work, and that the inventor, without knowledge of the patent law, can be of no material assistance, but the writer has found that the discussion of an office action, and the examination of the references, in connection with the applicant inventor is of material assistance in the preparation of the amendatory action or reply argument and

often enables him to get a much clearer insight himself into the real gist of the invention.

An action upon a case having been received, the first thing to do, of course, is to get copies of the references cited by the examiner, and this having been done, a notice should be sent to the applicant to come in and go over the matter with the attorney, preparatory to the work of amending. Before taking up the question with the applicant, however, it is well for the attorney to make a careful study of the references, and find out for himself just what bearing they have, if any, upon the rejected, or objectionable claims.

The applicant having put in an appearance in response to the summons, the several claims acted upon by the office can be gone over in detail, and the action of the office, and the bearing of the references, as the attorney sees it, can be explained to the applicant, who then in turn, can, and frequently does, make suggestions, as to points of difference or resemblance, which are of material aid.

In the course of such an interview it will be found of material assistance if the attorney makes a practice of taking note of such points as occur to him, either by himself, or from suggestions thrown out by the inventor, such notes to be used

in the preparation of the amendment. The amendment should be prepared as soon as possible after such interview, while the subject-matter is fresh in mind, and a practice of doing this regularly will save attorneys much unnecessary labor, and besides, result very advantageously to the procuring of a valid and properly worded patent.

The first thing in the preparation of an amendment is to meet the action of the examiner in order to do which, it is often, I think I may say generally, necessary to read not only the letter which the examiner has written, but also the subject-matter contained **between the lines** thereof. This will be understood by most attorneys who have had much dealing with the Patent Office, for it is a known fact amongst them that in acting on cases, the examiners, as a rule, do not fully or completely state the ground for their action, leaving considerable to be inferred, or deduced, from the subject-matter of the statements made. There is probably no attorney in the practice, who has not found, on an interview, that the examiner and the attorney have been working entirely at cross purposes, neither understanding the attitude of the other, and a five-minute talk will sometimes be sufficient to straighten out a case that has been a source of considerable annoyance and delay.

The first thing requiring attention in the preparation of an amendment, is, of course, the matters of form upon which objection has been raised by the office. These, as a rule, are not difficult to dispose of, and it is generally advisable, and proper, to meet the Office so far as possible upon technical requirements, and not waste time and energy in discussion as to nonessential points. Even assuming that the attorney does not agree with the Office, on the position taken, unless there is some good reason for starting a controversy, it is obviously better, to follow the requirements of the examiner, since thereby, if nothing else is accomplished, at least the work will be facilitated, and a more uniform practice established in the patent office.

In determining action upon the merits or essential parts of the case, great care should be exercised, and as bearing upon the statement already made, of the importance of finding out just what the attitude taken by the examiner is, it is to be observed that this can be frequently ascertained, by careful comparison of those claims which are rejected, with those, of which there are generally some, which have been allowed, noting carefully the distinction between the two. The reason for allowing some claims, and rejecting others, will generally be apparent on a careful comparison of each of the separate claims with the references.

Here great care should be exercised not to be misled into inserting into the rejected claims the limitations, characterizing the claims which have been allowed, for this would lead to duplication of claims, or to undue restriction of the patent, because of which the inventor would not procure a proper measure of protection. The suggestion as to comparison between the two classes of claims, is made only for the sake of finding out the attitude taken by the examiner, and knowing such attitude, of meeting the same by proper amendment and argument.

Where a claim is fairly and clearly met by a reference it is almost always the best practice to strike it out, not undertaking to get something allowed, which, it is evident, could not be sustained after it had been passed to issue. Of course the insertion of some amendment may enable the applicant to avoid the references, and this is often the shortest and easiest way to meet the difficulty, but in making such amendment or addition to the claim, great care should be exercised, as has been urged all along, not to put into all of the claims such limitations as will unduly restrict the patent. The same observation holds good here as was made in connection with the preparation of claims, name-

ly that the permutation system, should not be followed, that is, that each claim should stand by itself as though it were the only claim in the patent, and no limitation should be put in all of them, which is common to them all, if it can be avoided, since a better patent will be procured, where each claim depends for its differentiation from the prior art, upon some distinction peculiar to itself, and not present in the other claims.

In formulating amendments, great care should also be exercised not to strike out claims too hastily, and not to take too hasty an action in acquiescing in any respect in the action of the examiner, unless it is seen to be a proper and tenable one. Often times a little argument, and a careful showing of certain points, which the examiner has not grasped, will enable the applicant to remove the reference, without any amendment of the claim at all. In other cases, a proper amendment to the specification, will often times overcome the difficulty, without requiring a change in the claims, and this is preferable, if it can be accomplished, since the changes made in the claims, are frequently made the subject-matter of unfavorable decisions by the Court in after litigation.

It is to be observed that claims are often anticipated in **terms,** but not really in **substance,**

and the amendment to the claims should, if possible, be in the line, of substituting different terminology, which cannot be by any possibility the cause of confusion or misunderstanding in after interpretation of the patent. Sometimes when no suitable word can be found to substitute for that one which appears to be anticipated by the reference, proper amendment of the specification, setting out clearly just what the meaning of the term in the particular pending case is, will remove the objection.

In concluding this chapter it is to be said, that it is a practice on the part of many attorneys to slight the argument, which should accompany an amendment, or a request for reconsideration. The practice is one which cannot be too strongly condemned, since the Office is entitled to a clear and full statement of the position of the applicant, and on the part of the applicant, much better results can be expected on the whole, from proper and full presentation of the applicant's position, and reason for requesting reconsideration, or favorable consideration of new claims submitted. This recommendation holds good whether the examiner has properly performed his duty in the premises in this regard or not, and I think it may truthfully be said is especially to be observed where the examiner has

been lax in explaining his position, since it is evident that if the examiner will not study the case out for himself, or enter into a logical discussion of it, it must be clearly and fully spread out before him, if he is to be persuaded to take favorable action on the case. It may be, and in many cases undoubtedly is, very aggravating to have to do this, but it is something which should be done out of regard for the interests of the client, and should be treated, as in fact should all other points of this kind, in an entirely impersonal way. No other policy is admissable in a patent attorney's work, any more than it is in the work of any other professional man.

CHAPTER VII.

Legal Effect of Amendatory Actions.

In preparing amendments, one thing which it is important to keep in mind is the possible after effect in a legal way of such actions as may be taken in the nature of amendments. There is a disposition on the part of some Courts to pay a great deal of attention to the file history of an application as it goes through the Patent Office, and there is no doubt but that in many cases proper consideration should be given to the position taken by the applicant in overcoming the references cited by the Office and securing allowance of the claims. The fundamental point to be borne in mind in this regard is that no action should be taken which can be properly construed afterwards by any Court as estopping the patentee from urging such interpretation of his claims as will be co-extensive with his

invention. Thus for example, it will not do to urge in an argument contained in an amendment that certain limitations are imposed upon the claims with a view of avoiding a certain prior art reference, and then expect afterwards to persuade some Court to sustain the claims and give them an interpretation excluding such limitation.

One good rule to follow in connection with this matter is to formulate early in the proceedings a claim worded as nearly as possible to define exactly the invention which it is sought to cover, in as broad language as possible, and then to try and secure allowance of such claim by argument and persistent efforts and appeals if necessary, rather than by insertion of limitations, whether such limitations at the time are thought to be material or not by the attorney. It is bad practice to take a claim which is felt to be less than the applicant is really entitled to receive, by way of compromise with some position taken by the examiner which is thought not to be correct.

The writer has had personal experience in a number of instances where an examiner has been persuaded to withdraw an objection or a certain requirement, on representations as to the legal effect of compliance with such requirement.

It is often the case that cancellation of a cer-

tain claim or combination in an application acts to work an estoppel preventing the patentee from afterward urging an interpretation of claims granted co-extensive with the claim cancelled. This rule as thus broadly stated is not felt to be correct, however, because substantially the same patentable combination may be substituted in slightly different wording, and certainly an applicant cannot justly be held to have abandoned his right to any patentable combination stricken out of the application where another one of equivalent scope has been substituted in its place.

Another good rule to keep in mind, is that in making amendments it is desirable, where possible without too much inconvenience, to retain for a given claim the same number as it had when originally filed, whence can be avoided much confusion and misunderstanding on the part of the Court that may afterwards be called upon to examine the patent and file. The writer had occasion recently to examine an opinion in which an applicant was held to have been estopped from urging such interpretation of his patent as was embodied in a given claim, because a claim to such combination had been at one stage of the proceedings taken out —it having been overlooked that in an amendment filed at the same time, another claim with a dif-

ferent number had been inserted along with the amendment which substitute claim was word for word the same as the one which was before canceled.

It is obvious that if cases are originally filed with a very small number of claims—each one standing for something separate and distinct from the others, there will be much less amendatory work ordinarily required, and much less danger of confusion and troublesome legal consequences attaching to amendatory actions which subsequent events may prove were not wise.

It is to be hoped the day will soon come when a radical change will be made in the Office procedure, which will throw the burden with reference to amendatory actions, entirely upon the applicant or his attorney, which will certainly work a reform in this line of procedure. In a paper presented before the patent section of The American Bar Association at the meeting in 1905, by His Honor, Judge Duell, of the District of Columbia, there are a number of recommendations covering certain suggested improvements in the practice, and amongst these is one which is a modification of the present form of examination or procedure which contemplates in substance that there should be a thorough examination on the filing of an application, and then

one amendment by the applicant, then a second action by the Patent Office and then a final action by the applicant, which will on insistence of the applicant put the case to issue, or from which an appeal can be had if desired. According to this recommendation

> "The application as it stands after the applicant's second reply, should then pass to patent, unless the applicant should elect to take a prompt appeal to the examiners-in-chief in order to have a ruling by an appellate tribunal on the points of difference between him and the examiner. The applicant, to be permitted, but not required, to modify his application to meet the views of the examiners-in-chief."

As clearly pointed out by Judge Duell in the paper in question, the issued patent under such procedure should bear on its face sufficient data to give to the public the substance of what would be disclosed by an examination of the file-wrapper, and a great many advantages would follow the inauguration of such practice. Concerning this the paper says,

> "The advantages arising from such an examination are these: The examiners, having fewer examinations to make, could give more time to them. One thorough examination is worth half a dozen hastily made ones. The applicant would not be forced to cancel claims which he believed he was entitled to as, in fact, for various reasons, he often

now is. Patents would issue at an earlier day as a multiplicity of cross-actions would be obviated and the number of appeals brought within bounds. The presumption of novelty would not be materially lessened, and the later validity search would not be more laborious."

The writer is firmly convinced that some such change in practice will be found to be absolutely essential before a great while, in view of the great increase in business in the Patent Office, and the enormous increase in the number of references, and the difficulty of properly handling the work under the present procedure. If to a new practice along the lines recommended, were added certain restrictions and requirements—as for example, material limitations in the number of claims and simplification of the application in general, such as would accompany such restriction in the claims, and strict limitation of the illustration and descriptive matter to such matter as was claimed, the whole patent system will have taken a very marked step in advance.

CHAPTER VIII.

Amendments Accompanied by Affidavits.

It is to be observed that in many cases—especially under the present practice, there is a legitimate difference of opinion between the applicant or the applicant's attorney and the examiner in the Patent Office with reference to the allowability of certain claims which are being urged in an application, and one method of overcoming this difficulty is the filing of affidavits covering the points in controversy. It will be found in many cases that differences of opinion arise as to matters of operativeness, or as to practical importance of certain features, or the value or utility of certain elements of the combination urged, and in all such cases it will be found that much value attaches to the use of properly framed affidavits.

Thus for example, in case of difference of opinion with the Patent Office as to the operative-

ness of a certain combination, there are very few divisions in which the objection cannot be overcome by filing suitable affidavits based upon practical test of responsible parties who swear to the making of such test and to the successful results accomplished. Affidavits of people skilled in the art or experts in certain particular lines of work are sometimes of value also in comparing claims urged with prior art structures shown in references cited against such claims, indicating wherein such prior art structures in result or function, or operation fall short of the claimed combination. Affidavits showing extensive public use and successful introduction over competing devices are also of advantage in some instances, and in fact in a great many cases will serve to turn the scale in the favor of an applicant where the mind of the examiner is in doubt. It is scarcely necessary to say that in connection with the preparation and filing of such affidavits great care should be exercised, and everything except actual consideration of facts should be rigidly excluded.

There is still another class of affidavits filed in connection with amendments, in the prosecution of applications for patent, this class having reference to Patent Office Rule No. 75, which specifies that where a case is rejected on reference, and the

applicant shall make oath to "facts showing the completion of the invention in this country before the filing of the application," on which the reference, if it be a U. S. patent, issued, or before the date of the foreign patent if the reference be foreign, and shall also make oath that he does not know and does not believe that the invention has been in public use or on sale in this country, etc., then such reference "will not bar the grant of a patent to the applicant," unless the date of such patent or publication is more than two years prior to the date on which the application was filed in this country. This rule permits a reference to be avoided by the submission of the oath in question, but it is to be observed that the oath is not a mere statement by the applicant that he conceived or thought of the invention prior to the date in controversy, but a statement of "facts" showing a completion of the invention in this country, and it must be accompanied with sketches or prints together with other data showing not only the conception of the idea, but the actual completion of the invention in question, and such showing should be clear and conclusive.

Rule 76 also is of similar character, and in case of rejection of a claim on certain references permits the filing of an affidavit, or "deposition" sup-

porting or traversing these references or objections, which affidavits or depositions it is to be observed should also of course follow the lines indicated in connection with rule 75, and not incorporate a mere statement of opinion or unsupported allegation of the applicant himself.

CHAPTER IX.

Interferences.

In the rules of practice, No. 93, an interference is defined as follows:

> "An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention. The fact that one of the parties has already obtained a patent will not prevent an interference, for, although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor."

Early in the history of the Patent Office it was found that provision would have to be made to determine the matter of priority as between two contesting applicants for the same invention.

"Interfering applications" as they have been called, seem to have been first recognized in our law, in 1793, for the original patent act which was

dated 1790, makes no mention of them, while the Act of 1793, section 9, provided "that in case of interfering applications, the same shall be submitted to the arbitration of three persons, one of whom shall be chosen by each of the applicants, and the third person shall be appointed by the Secretary of State;" * * * "and the decision or award of such arbitrators, * * * or any two of them, shall be final as far as respects the granting of the patent." This section further provided that "if either of the applicants shall refuse or fail to choose an arbitrator the patent shall issue to the opposite party." Furthermore it was provided that "where there shall be more than two interfering applications, and the parties applying shall not all unite in appointing three arbitrators, it shall be in the power of the Secretary of State to appoint three arbitrators for the purpose."

To the modern practitioner in patent law the simplicity of the above provision is almost startling. It is submitted, however, that upon careful examination it will be found to have in it many elements of good common sense, which is something that certainly cannot truthfully be said of some of the provisions of the law and practice in interferences as it exists to-day.

The Act of 1836 created a regular Board of Ex-

aminers of three persons appointed by the Secretary of State, which board had jurisdiction of appeals in cases of rejected applications and also in cases of interfering applications, having authority to reverse the decision of the Commissioner of Patents in such cases. Section 16 of this same Act provided that any party interested who felt aggrieved by the decision of the board of examiners in any interference case, as also in any case of rejected applications, should "have remedy by bill in equity," which, by the provisions of another section of the same Act had to be filed in some United States Circuit Court or in some United States District Court having Circuit Court jurisdiction."

The Act of 1861 created a new board of three Examiners-in-Chief to be appointed by the President, and this board was given jurisdiction of appeals from the examiners in interference cases as well as in applications, and by the same section provision was made for appeal from their decision to the Commissioner of Patents in person. The office of Examiner of Interferences was created by the Act of 1870, which gave such examiner charge of interference cases and provided appeal from his decision to the board of examiners-in-chief.

The consolidated patent Act of 1870, besides

creating the office of examiner of interferences heretofore noted, made another change in the course of practice in interference cases, by excepting such cases from those appealable to the Supreme Court of the District of Columbia, leaving as the only remedy in case of rejection by the Commissioner in person, the filing of a bill in equity in some United States Circuit Court, according to the provisions contained in the Patent Act of 1836. By an Act dated February, 1893, the Circuit Court of Appeals of the District of Columbia was created, and to that Court was given jurisdiction of appeals from the Commissioner of Patents in interference cases as well as in cases of rejected applications, and such is the law to-day.

From a most careful examination of the several patent statutes relating to appeals and proceedings in interference cases, it is evident that it was never the intention of Congress to build up any such elaborate and complicated system of procedure as exists to-day by virtue of the growth of the Patent Office Rules in this department. The simplicity of the early provision allowing the appointment of the three arbitrators and making their decision final is in striking contrast to the number of appeals at present allowed—as many as five being in fact possible, if the Bill in Equity be included—and

also the large number of interlocutory motions and petitions of one kind or another which are permitted under the rules as they stand.

As the matter stands to-day, there is, first, the formal declaration of interference. Until the declaration the primary examiner under rule 100 retains jurisdiction of the case. Upon the declaration or institution of the interference, the examiner of interferences takes jurisdiction of the case which is then said to become a contested case. But in spite of this the primary examiner under the rules still has jurisdiction to determine the several motions mentioned in other rules—as for example, with reference to the question of non-patentability of the issues, and lack of interference in fact.

It is next provided by the rules that after the formal declaration of interference a preliminary statement must be prepared and sealed up and filed. After this has been opened at a certain date the examiner of interferences will appoint dates for the taking of testimony. The rules next prescribe certain motions which may be brought—as motion for dissolution on various grounds—all of which have to be passed upon formally by the examiner of interferences and then referred back to the primary examiner for determination on the merits.

After the several motions and statements are

out of the way, the next step is the taking of testimony, which is done according to certain rules and involves considerable expense and the expenditure of a large amount of time, and then after all of this is done and the briefs prepared, the case comes up for oral hearing.

The first hearing on the matter of priority is before the examiner of interferences. From his decision an appeal will lie to the board of examiners-in-chief, and from the board of examiners-in-chief to the Commissioner in person. If the Commissioner's decision is not satisfactory, either party may appeal on the matter of priority, under the present statutes, to the Court of Appeals of the District of Columbia, and after the matter has been decided by this Court there still remains a bill in equity originated in the Act of 1836 above referred to, which is in reality a new suit and raises the whole question over again where it can be heard in the Circuit Court of the United States and afterwards taken to the United States Circuit Court of Appeals for the Circuit in which the suit under this provision of the statute is brought. Such a line of procedure and such a multitude of appeals and such an enormous expense as the same involves is a disgrace to the whole patent system of the United States. The condition is very well described in the

statement by his Honor, Judge Duell, in a paper presented before the section on patent law of the American Bar Association, in 1905, from which we quote as follows:

> "From the simple and summary mode first adopted for determining the question of priority of invention, that proceeding by a system of Patent Office rules, has grown to be a veritable old man of the sea, and the unfortunate inventor who has become involved therein is a second Sinbad the Sailor. It is known to all who are familiar with the practice in interference proceedings that by motions, petitions and appeals of every conceivable character that the ingenuity of the skilled attorney can devise, interferences can be and are prolonged for years to the injury of the public and often to the financial ruin of the parties."

The abuses that have arisen under the present system have been fully and exhaustively considered in a paper by Mr. Joseph B. Church on some needed reforms in interference practice read before the patent section of the American Bar Association in 1905, and from such paper which appears to cover the case admirably, we take the liberty of quoting the remedies proposed, as follows:

> "The remedy is at once simple and complete, and it is within the power of the Patent Office to apply it without additional legislation on the subject."
>
> "It is this: Restore to the examiner of inter-

ferences exclusive authority to determine all jurisdictional issues, such as questions involving patentability of the subject matter, the right of an applicant to make the claim, regularity in the declaration and interference in fact."

"Abolish all interlocutory appeals in these issues, both to the Commissioner and to the examiners-in-chief."

"Adopting the procedure of the equity courts in such cases, provide for the trial of jurisdictional issues on motion, with notice, either before testimony taken or at final hearing, in analogy to like proceedings under demurrer, plea or answer. A decision sustaining jurisdiction, if rendered on motion before testimony taken, should require that the cause proceed to final hearing; if rendered after final hearing, it should accompany judgement on the merits. In either event, the decision on the jurisdictional issue will be merged in the final judgment."

"A decision adverse to jurisdiction should be followed by an order (decree) of dissolution (dismissal)."

"In this way all contentions of the parties would be embodied in a final decision, disposing entirely of the controversy, and would be the subject of appeal under sec. 4909 R. S."

As clearly pointed out by Mr. Church in the paper in question, the change suggested therein could be made without departing from the present existing statute and without in any respect materially altering the general scheme at present in

force, fundamentally considered. With reference to further procedure if the suggested alteration were to be adopted, Mr. Church says:

> "The reversal of judgment of dissolution would be accompanied by an order sending the case back for hearing on the merits; just as an appellate court, on reversing the decree of the trial court, dismissing a suit for want of jurisdiction, remands the case with directions to proceed to a hearing on the merits of the cause."
>
> "As a substitute for the interlocutory appeals now provided, and in order to obtain the benefit of the primary examiner's supposed familiarity with the art to which the invention pertains, the examiner of interferences should be given power to refer, at his discretion, jurisdictional issues to the primary examiner for a preliminary hearing, the latter, after the manner of a master in equity, reporting his findings and conclusions to the examiner of interferences. Exceptions may be taken and filed to the primary examiner's report, and a final hearing had thereon before the examiner of interferences, who shall thereupon render a decision on the issues raised. If no exceptions are taken to the primary examiner's report, and as to matters not excepted to, where exceptions are filed, the findings of the primary examiner on questions of fact should, ordinarily, be adopted by the examiner of interferences."
>
> "The introduction of a system such as that outlined would not seriously conflict with the rules at present in force, but, with slight modifications and

amendments, they could readily be rendered compatible therewith."

The matter of the existing abuses and the proposed reform of the same suggested in Mr. Church's paper has been given considerable attention in this chapter, because it is felt that it is something that must have early action or serious consequences are almost sure to follow. The writer has personal knowledge of instances where fear of the expense and annoying delays incident to these long drawn out interference proceedings has been a serious detriment to the patent practice, and has discouraged many applicants from venturing to secure that protection for their meritorious improvements to which they are justly entitled under the law.

CHAPTER X.

Final Notice of Allowance; Payment of Final Fee; Transfer of Files to Issue Division; Withdrawal of Cases from Issue; Issue of Patents.

The final proceedings in connection with an application are the sending by the Patent Office to the applicant or his attorney, of what is known as Final Notice of Allowance, after all of the points in controversy connected with the application have been successfully disposed of, which final notice of allowance is sent out by the issue division after the files of the case have been transferred to the same from the examiner previously in control of the application. In connection with this final notice of allowance there is always a statement to the effect that within six months from the date thereof the final fee of twenty dollars must be paid in order to secure the issue of patent, and other instructions regarding the formalities incident to the procedure.

At any time within six months from the date of such final notice the final government fee may be paid to the Commissioner, and after the payment of the same the necessary preliminary work is done, and three weeks later, approximately, the patent issues.

It sometimes happens that after cases have been finally allowed and transferred to the issue division, it is necessary to withdraw them from the issue division, as for example, when the examiner finds some new application filed which should be put in interference with a case that has been sent to the issue division, whereupon on request of the primary examiner to the Commissioner, the case will be taken from the issue division and sent back to the primary examiner to be inserted in such interference. For any reason or cause assigned by the applicant or his attorney, it is difficult, however, to get any case withdrawn from the issue division, and if a case is found to require amendment after it has been passed to the issue division, about the only way to accomplish such amendment is to allow the case to forfeit for non-payment of the final fee within the six months allowed, and then to renew the application by the payment of a renewal fee of fifteen dollars. Of course there are certain legal consequences liable to follow from

such action, but these will not be considered in detail here.

If, as stated, the final fee be paid within the six months after the date of the notice of final allowance, the drawings are photolithographed and the specification prepared for printing, so the patent will issue on the third Tuesday after the first Thursday following the payment of the final fee.

Ex. E. H.R
3/6/07